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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,243	01/21/2000	CHARLES R. HASKINS	064385-5030	3704
<div>9629 7590 09/10/2007 MORGAN LEWIS &amp; BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004</div>			<div>EXAMINER SUBRAMANIAN, NARAYANSWAMY</div> <div>ART UNIT PAPER NUMBER 3692</div> <div>MAIL DATE DELIVERY MODE 09/10/2007 PAPER</div>	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/381,243

Applicant(s)

HASKINS ET AL.

Examiner

Narayanswamy Subramanian

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**Period for Reply**  
The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11 and 13-46 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This communication is in response to Applicant's communication filed on June 27, 2007. Amendments to claims 1, 6, and 44 have been entered. Claims 1-11 and 13-46 are pending in this application and are subject to election/restriction as discussed below.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5, drawn to a method for modeling an investment fund mix to produce a projected guaranteed accumulation investment amount for a user over a predetermined time period equal to at least a preselected guaranteed accumulated investment amount selected by the user comprising the steps of: designating funds for investment to produce the fund mix; comparing a diversification guideline to the fund mix, wherein said diversification guideline contains guidelines relating to fund diversification and investment objective diversification; completing an information file for the user; determining a pattern of investments to meet the preselected guaranteed amount; applying the diversification guideline to the information file to determine whether the information file meets the guideline; automatically calculating the projected guaranteed amount based on projection of fund performance; and comparing the projected guaranteed amount to the preselected guaranteed accumulated investment amount, classified in class 705, subclass 36R. A utility of this group of claims is applying a diversification guideline to the information file to determine whether the information file meets the guideline.

II. Claims 6-8, drawn to a method for identifying a fund mix for producing a projected accumulation investment amount exceeding a preselected amount for a user

comprising the steps of: calculating the projected accumulation investment amount by projecting fund performance; inputting a time period for producing the maximum accumulation investment amount; inputting a probability of the projected accumulation investment amount exceeding the preselected amount; automatically searching predetermined probability distributions for potential funds for the fund mix; automatically listing a plurality of potential funds by projected accumulation investment amount produced using the predetermined probability distributions for the potential funds; comparing a diversification guideline to the plurality of potential funds; and automatically combining a plurality of potential fund meeting the diversification guideline to produce an optimum fund mix that will produce a projected accumulation investment amount exceeding the preselected amount, classified in class 705, subclass 36R. A utility of this group of claims is automatically listing a plurality of potential funds by projected accumulation investment amount produced using the predetermined probability distributions for the potential funds.

III. Claims 9-11, 13-23 and 45-46 drawn to a method for projecting an accumulated investment amount for a portfolio having a plurality of funds over a preselected time period for a user, comprising the steps of: inputting initial and periodic contributions and fund allocations for the plurality of funds; completing a projection method parameters file in which various parameters are identified, including a probability that a fund will exceed a projected yield in any year; automatically calculating the time needed to process a projection of the accumulated investment amount for the portfolio having the plurality of funds; and automatically performing the projection of the accumulated investment amount for the portfolio having the plurality of funds, classified in class 705, subclass 36R. A utility of this group of claims is automatically

calculating the time needed to process a projection of the accumulated investment amount for the portfolio having the plurality of funds.

IV. Claims 24-26 and 41-43, drawn to a method for modeling a fixed retirement income amount for a user over a predetermined time period after a preselected delay period comprising the steps of: (a). inputting an issue commission of zero percent, a best estimate for treasury security yields, and a plurality of additional basis point spreads; (b). automatically applying an annuity calculator to produce a current projected fixed retirement income amount; and (c). automatically repeating steps (a) and (b) for a range of treasury security yields and for each of the plurality of additional basis point spreads, classified in class 705, subclass 36R. A utility of this group of claims is automatically applying an annuity calculator to produce a current projected fixed retirement income amount.

V. Claims 27-29, drawn to a method for pricing fund charges for an investment fund equal to at least a preselected guaranteed accumulation investment amount over a predetermined time period selected by a user comprising the steps of: creating a plurality of information sets corresponding to a plurality of potential users; automatically projecting a plurality of monthly charges for producing a plurality of projected guaranteed accumulation investment amounts for each of the plurality of information sets; automatically deducting and accumulating the plurality of monthly charges; for each of the plurality of projected guaranteed accumulation investment amounts, automatically adding the accumulated monthly charge and subtracting the projected guaranteed accumulation investment amount to produce a probability distribution providing a range of net values; and selecting one from the plurality of monthly charges that produces zero value for the probability and distribution produced, classified in class 705, subclass 36R. A

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utility of this group of claims is selecting one from a plurality of monthly charges that produces zero value for a probability and distribution produced.

VI. Claims 30-31, drawn to a method for processing a selected guaranteed accumulation investment amount for a user over a predetermined time period equal to at least a preselected guaranteed accumulated investment amount selected by the user comprising the steps of: inputting a plurality of funds each of the plurality of funds having a value; automatically generating a fund guarantee statement; automatically generating a probability distribution of projected accumulation amounts; automatically deducting a charge on a periodic basis; and automatically generating an electronic fund report, classified in class 705, subclass 36R. A utility of this group of claims is automatically generating a fund guarantee statement.

VII. Claims 32-34, drawn to a method for combining electronic fund reports for a client for a plurality of funds and a plurality of transactions for the plurality of funds wherein each of the plurality of funds has an amount, comprising the steps of: automatically determining whether all of the plurality of funds have reported; automatically matching the plurality of transactions to the plurality of funds; determining whether diversification guidelines are met for the plurality of funds and plurality of transactions; automatically generating withdrawal and deposit instructions for the plurality of funds; and automatically determining whether the total contributions exceed a predetermined amount, classified in class 705, subclass 36R. A utility of this group of claims is automatically determining whether all of the plurality of funds have reported.

VIII. Claims 35-40, drawn to a method for processing for a user a guaranteed accumulation investment amount for a plurality of variable annuities with a fixed retirement

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income guaranteed amount having a maturation date comprising the steps of: inputting user specific data; automatically generating a proposal for a guaranteed minimum benefit rider; automatically generating a contract data page; automatically issuing a contract with a guaranteed minimum income benefit rider; automatically deducting a daily cost charge; receiving transactions for the account; comparing a variable annuity diversification guideline to the received transactions for the account; automatically generating withdrawal and deposit instructions for the received transactions; automatically determining whether the total contributions exceed a predetermined amount; automatically determining the guaranteed accumulation investment amount; and automatically periodically transmitting information about the account to the user, classified in class 705, subclass 36R. A utility of this group of claims is automatically generating a proposal for a guaranteed minimum benefit rider.

IX. Claim 44, drawn to a method for determining a reserve for an investment fund mix producing a guaranteed accumulation investment amount for a plurality of users over a predetermined time period, wherein the investment fund mix includes a plurality of selected funds, each of the plurality of selected funds having a value, comprising the steps of: automatically identifying for each of the plurality of users each of the plurality of selected funds for which the value of the selected fund is less than the guaranteed accumulation investment amount; automatically summing the difference between each of the plurality of selected fund for which the value of the selected fund is less than the guaranteed accumulation investment amount for each of the plurality of users to produce a total difference; and automatically increasing the total difference by a reserve factor, classified in class 705, subclass 36R. A utility of this claim is automatically identifying for each of the plurality of users each of the plurality of selected funds

for which the value of the selected fund is less than the guaranteed accumulation investment amount.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. As is obvious from the preambles, the steps of the methods and their separate utility, the inventions are distinct from each other. See MPEP § 806.05(d). Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper, even though they are classified in the same class and subclass.

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. As is obvious from the preambles, the steps of the methods and their separate utility, the inventions are distinct from each other. See MPEP § 806.05(d). Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper, even though they are classified in the same class and subclass.



Similarly other pairing of inventions stated above are related as sub combinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. As is obvious from the preambles, the steps of the methods and their separate utility, the inventions are distinct from each other. See MPEP § 806.05(d). Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper, even though they are classified in the same class and subclass.

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Applicant is advised that reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

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(571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at (571) 272-6702. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian  
Primary Examiner  
Art Unit 3692

September 3, 2007